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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,395	02/27/2004	Takanori Hioki	Q80156	4810

23373 7590 06/29/2005

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WASHINGTON, DC 20037

EXAMINER

LETSCHER, GERALDINE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/787,395

Applicant(s)

HIOKI ET AL.

Examiner

Geraldine V. Letscher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2-27-04, 7-19-04 & 4-22-05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7-19-04.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-12 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by Hioki et al. (U.S. Patent Application Publication No. 2003/0228549 = copending Application No. 10/199,044) which has a common assignee/inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application.

Hioki et al. discloses a silver halide photographic light-sensitive material comprising a silver halide photographic emulsion containing at least one multi-chromophore dye compound having at least two dye chromophores connected by covalent bonding or coordinate bonding, at least two of said dye chromophores forming a dye chromophore group and the light absorption of said dye chromophore group differing from the sum of individual light absorptions of respective dye chromophores constituting said dye chromophore group, characterized in that:

said dye chromophore group is in the aggregated state;

the absorption maximum wavelength of said dye chromophore group is longer than the maximum wavelength of the sum of absorptions of individual dye chromophores;

a dye chromophore is adsorbed in multiple layers on the surface of a silver halide grain;

the silver halide photographic emulsion in said photographic light-sensitive material is an emulsion where tabular grains having an aspect ratio of 2 or more is present in a proportion of 50% (area) or more of all silver halide grains in the emulsion;

and the silver halide photographic emulsion in said photographic light-sensitive material is subjected to selenium sensitization.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of Hioki et al. (U.S. Patent Application Publication No. 2003/0228549). Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a silver halide photographic light-sensitive material comprising a silver halide photographic emulsion containing at least one multi-chromophore dye compound having at least two dye chromophores connected by covalent bonding or coordinate bonding, at least two of said dye chromophores forming a dye chromophore group and the light absorption of said dye chromophore group differing from the sum of individual light absorptions of respective dye chromophores constituting said dye chromophore group, characterized in that:

said dye chromophore group is in the aggregated state;

the absorption maximum wavelength of said dye chromophore group is longer than the maximum wavelength of the sum of absorptions of individual dye chromophores;

a dye chromophore is adsorbed in multiple layers on the surface of a silver halide grain;

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the silver halide photographic emulsion in said photographic light-sensitive material is an emulsion where tabular grains having an aspect ratio of 2 or more is present in a proportion of 50% (area) or more of all silver halide grains in the emulsion; and the silver halide photographic emulsion in said photographic light-sensitive material is subjected to selenium sensitization.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Prior Art***

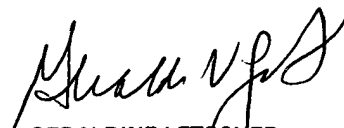
4. The following prior art made of record and not relied upon is considered pertinent to applicants' disclosure: U.S. Patent No. 6,361,932 (column 36, line 36); U.S. Patent No. 6,331,385 (column 44, line 1); U.S. Patent No. 6,165,703 (column 24, line 1); U.S. Patent No. 6,143,486 (column 30, line 60). Each of these references teaches a silver halide photographic light-sensitive material containing at least one multi-chromophore dye compound having at least two dye chromophores including a J-aggregate dye and an H-aggregate dye.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geraldine V. Letscher whose telephone number is (571) 272-1334. The examiner can normally be reached 7:30am to 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (571) 272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
GERALDINE LETSCHER  
PRIMARY EXAMINER  
GROUP 1100